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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,832	07/25/2003	Nick Davis Poynter	620-262	9237

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EXAMINER	
HUMPHREY, LOUISE WANG ZHIYING	

ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/626,832	DAVIS POYNTER ET AL.	
	Examiner	Art Unit	
	Louise Humphrey, Ph.D.	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2003*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-42* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *See Continuation Sheet*.

Sequence Compliance

The claims are objected to for failing to adhere to the requirements of the sequence rules. Applicant must append SEQ ID NOs. to all mentions of specific sequences in the claims. See 37 CFR §1.821(d). Full compliance is required in response to this Restriction Requirement. A reply that fails to comply will be considered to be non-responsive and may result in abandonment of this application. See attached notice.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-3, drawn to a method for subtyping, classifying, identifying or monitoring an EHV-1 isolate using a genetic marker, classified in class 435, subclass 6.

II. Claims 4-24 and 42, drawn to a method for assessing the virulence of an EHV-1 or EHV-4 isolate using a genetic marker, classified in class 435, subclass 6.

III. Claims 25, 26, 31 and 32, drawn to a pair of oligonucleotide primers specific for the ORF30-m1 region, classified in class 536, subclass 24.3.

IV. Claims 27 and 33, drawn to a pair of oligonucleotide primers specific for the ORF68 region, classified in class 536, subclass 24.3.

V. Claims 28-30, drawn to an oligonucleotide primer, classified in class 536, subclass 24.3.

VI. Claims 34 and 35, drawn to a method for preparing a recombinant herpesvirus vaccine strain, classified in class 435, subclass 456.

VII. Claims 36-38, drawn to a live herpesvirus vaccine, classified in class 424, subclass 199.1.

VIII. Claims 39 and 40, drawn to a method for immunizing a host against a herpesvirus disease, classified in class 424, subclass 199.1.

IX. Claim 41, drawn to an isolated peptide comprising a contiguous portion of at least 10, 15, 20, 30, 40, or 50 amino acids of the amino acid sequence of the ORF30 sequence of an EHV-1 isolate, classified in class 530, subclass 826.

The inventions are distinct, each from the other because of the following reasons:

Inventions VI and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method can be practiced with protein peptides or aptamers.

Inventions (I, II, VII) and (III, IV, VIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially

different process of using that product (MPEP § 806.05(h)). In the instant case the nucleotide primers can be used in hybridization or generation of anti-sense oligonucleotides.

Inventions I, II, VI, and VIII are unrelated because they are independent methods with different modes of operation, with respect to starting materials, physiological or chemical mechanisms, protocol procedures, and end products; therefore, each method is patentably distinct.

Inventions III-V are distinct from Invention IX as a different chemical entity; Inventions III-V are oligonucleotides composed of nucleic acids whereas Invention IX is a protein directed to amino acids. Each has a different chemical composition, structure, function, and physiological activity. Further, Inventions III-V are different oligonucleotides of different nucleic acid sequences and different binding specificity; therefore each product is patentably distinct.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matter, and require non-coextensive literature and sequence searches even though in some cases the classification is shared, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Sequence Election

Regardless of which of the above inventions is elected, further restriction is required under 35 U.S.C. §121:

One specific sequence with a SEQ ID NO must be elected.

The inventions are distinct, each from the other, because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. §806.05 for inventive groups that are directed to different sequences, restriction is deemed proper because these products constitute patentably distinct inventions. Each of the SEQ ID NO's is a unique and separately patentable sequence, requiring a unique search for the prior art. Searching all of the sequences in a single patent application would constitute an undue search burden on the examiner and the USPTO's resources because of the non-coextensive nature of these searches.

Further, Inventions of different SEQ ID NO's are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represent structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louise Humphrey, Ph.D. whose telephone number is 571-272-5543. The examiner can normally be reached on Mon-Fri, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Louise Humphrey, Ph.D.
Patent Examiner
23 January 2006

JEFFREY STUCKER
PRIMARY EXAMINER

Continuation of Attachment(s) 6). Other: notice to comply with sequence rules.

Application No. 10/626,832

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821 - 1.825 for the following reason(s):

☒ 1. This application clearly fails to comply with the requirements of 37 CFR 1.821 - 1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.

☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c).

☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).

☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing."

☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).

☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).

☐ 7.

Other: _____

Applicant must provide:

☐ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing"

☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification/claims.

☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d)

For questions regarding compliance with these requirements, please contact:

For Rules Interpretation, call (703) 308-1123
For CRF submission help, call (703) 308-4212
For PatentIn software help, call (703) 557-0400

Please return a copy of this notice with your response.